

REMARKS

In the Office Action mailed November 29, 2005, the Examiner rejected claims 11-13, 16, 19 and 21-28, objected to claim 14, but indicated claim 14 as allowable in independent format and indicated claims 1 and 5-10 as allowed. Applicants thank the Examiner for the indication of allowed and allowable subject matter. Applicants have not currently amended the claims of the present application and respectfully request reconsideration of the current claims.

I. Information Disclosure Statement

The Office Action suggested non-consideration of EP 1134126 and WO 05/044630. Applicants submit herewith a Supplemental Information Disclosure Statement re-listing those two references along with other references. Applicants have also included copies of those references and respectfully request consideration thereof.

II. Claim Rejections under 35 USC 103

The Office Action rejected claims 11-13, 16, 19 and 21-28 under 35 USC 103 as being obvious over Schneider (U.S. Patent Application Publication 2002/0171260) or Czaplicki (U.S. Patent 6,471,285) in view of Gahlau (U.S. Patent 4,655,496). Applicants traverse the rejections of these claims on one or more of the following grounds: 1) The Office Action does not establish a *prima facie* case of obviousness against the claims of the present application; 2) The Office Action does not provide a motivation sufficient to maintain its obviousness rejections; and/or 3) It is legally impermissible to use the Schneider and Czaplicki references to reject at least claims 22-28 of the present application.

As stated in the MPEP 2143.03, "To establish *prima facie* obviousness...all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim again the prior art." *In re Wilson*, 424 F2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, The Court of Appeals for the Federal Circuit, in the case of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), wrote:

("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Claim 11 and its dependents

The Office Action rejected claim 11 and its dependents under 35 USC 103 as being unpatentable over Schneider (U.S. Patent Application Publication 2002/0171260) or Czaplicki (U.S. Patent 6,471,285) in view of Gahlau (U.S. Patent 4,655,496). Applicants traverse these rejections.

The Office Action admits that, "Schneider may not require placement of the structure between a passenger compartment and an engine compartment of the automotive vehicle." The Office action also admits that, "Czaplicki may not require placement of the structure between a passenger compartment and an engine compartment of the automotive vehicle." Furthermore, the Office Action provides no specific reason or motivation suggesting the desirability of using the structures of Schneider or Czaplicki at a location between the passenger compartment and the engine compartment. As such, the Office Action has failed to show how the prior art suggests the claimed invention and has therefore failed to provide a motivation sufficient for maintaining the obviousness rejections against claim 11 and its dependents.

Applicants acknowledge that the Office Action has used Gahlau to suggest that "noise blocking between the engine and passenger compartments is indeed a major concern in automotive construction" and that the Office Action has suggested that this concern suggests the obviousness of applying Schneider or Czaplicki between the passenger compartment and the engine compartment. However, the mere fact that noise blocking between the engine and passenger compartments is a concern does not provide a motivation to apply the structures of Schneider and Czaplicki to that region.

The Office Action provides no particular motivation or even suggestion of the suitability of the structures of Schneider and Czaplicki to a location between the engine and passenger compartment. Moreover, Schneider provides a structure particularly suitable for use in a door of a vehicle while Czaplicki provides a structure particularly suitable for application to frame rails, hydroformed tubes or the like. Applicants find no suggestion for using these structures as recited in claim 11. As such, Applicants contend that the Office Action has failed to establish the obviousness of claim 11 and its dependents and the rejection of those claims should be withdrawn.

In addition to the above, Applicants further contend that the Office Action has failed to establish a *prima facie* case of obviousness against claim 11 and its dependents because it has not shown certain portions of the subject matter of those claims to be in the prior art or the knowledge of the skilled artisan. The Office Action has failed to address the following, alone or in combination, with respect to claim 11 and its dependents:

- 1) In claim 11: i. a viscoelastic adhesive and a structural adhesive bonded to the panel and layer of foam material; and ii. a panel and a layer of foam material bonded to both adhesives.
- 2) In claim 12: at least 50% of the space between the panel and the layer of foam material is filled by the viscoelastic adhesive.
- 3) In claim 13: the structural adhesive is a continuous or non-continuous strip extending adjacent a peripheral edge of the panel or layer.
- 4) In claim 17: the panel and layer being substantially coextensive with each other.

Applicants contend that this failure to address the subject matter of claims 11 and its dependents is failure to establish obviousness of those claims. As such, Applicants request the withdrawal of the rejections of claim 11 and its dependents.

In addition, the Office Action has failed to show specifically how Czaplicki or Schneider include the panel, layer and adhesives of claim 11 and its dependents according to the configurations discussed in those claims.

With regard to claim 16, Applicants acknowledge that the Office Action suggests that the thicknesses recited in that claim are merely an optimization. However, this suggestion ignores the choice and arrangement of materials for claim 16, which, in turn, as discussed in

the data presented in the application, can provide desired sound attenuation and/or heat dissipation at the claimed thicknesses.

In conclusion, Applicants contend that none of the references cited in the office action, singly or in combination, disclose or suggest a structure that, as recited in claim 11, includes: 1) a panel formed of a metal; 2) a layer of magnesium and/or aluminum foam; 3) a viscoelastic adhesive that is bonded to the panel and the layer of foam material; and 4) a structural adhesive that is bonded to the panel and the layer of foam material wherein the structural adhesive is a heat expandable material and wherein the structure is located between a passenger compartment and an engine compartment of the automotive vehicle. This is particularly the case where, as in claim 17, "the panel and the layer of foam material are substantially coextensive with each other". Applicants respectfully request that the rejection of claim 11 and its dependents be withdrawn.

Claim 22 and its dependents

Applicants traverse the rejection of claim 22 and its dependents as failing to provide a proper motivation for the combination Gahlau with Schneider or Czaplicki based upon the same reasoning as provided above and for all the other reasons discussed above. Additionally, however, Applicants contend that Schneider and Czaplicki only qualify as prior art under 102(e) since the priority date of the present application is July 25, 2002. As such, Schneider and Czaplicki are not valid as references in the asserted 103 rejections of claim 22 and its dependents of the present application, because Schneider, and Czaplicki are currently and have always been wholly owned by a single entity, the Assignee of the present application, L&L Products.

Applicants request that the rejections of claim 22 and its dependents be withdrawn.

Claim 28

Applicants also assert that the Office Action has failed to establish a *prima facie* case of obvious against claim 28. The Office Action fails to establish that the cited references disclose or that the knowledge of the skilled artisan includes at least the following:

- i) the panel having a thickness of between about 1.0 mm and about 2.0 mm;

- ii) the viscoelastic adhesive being thermally expandable from about 5% to about 2000% its original size at a temperature of 200 °F or greater, the layer of viscoelastic adhesive being between about 0.5 and about 2.0 mm thick; and
- iii) the layer of metal foam being between about 12 mm and about 15 mm thick;
- iii) the layer of foam is closer to the engine than the panel.

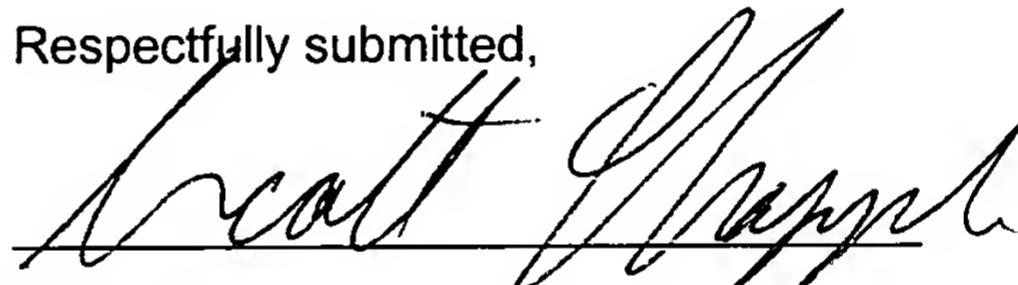
Applicants request that the rejection of claim 28 be withdrawn.

### CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,



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